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**REMARKS**

Claims 1-13 and 22-35 are currently pending in the application.

Claim 8 is objected to under 35 U.S.C. §112, second paragraph, as being indefinite because Applicant has not yet provided a copy of the procedure used to measure water vapor transmission rate.

Claims 1-4, 8, 11, 12 and 22-35 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,876,551 to Jackson "as further evidenced by" the Abstract of WO 95/07946. Claims 1, 3-5, and 11-12 stand rejected under 35 U.S.C. §102(e) as being anticipated by Gundberg et al. (U.S. Patent No. 6,203,646). Claim 2 stands rejected under 35 U.S.C. §102(e) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Gundberg et al. Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gundberg et al., as applied to claims 1, 3-5, and 11-12 above, and further in view of Penz et al. (U.S. Patent No. 5,888,913). Claims 9, 10, and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gundberg et al., as applied to claims 1, 3-5, and 11-12 above, and further in view of Melber et al. (U.S. Patent No. 4,898,892).

**Rejection of claim 8 under 35 U.S.C. §112, second paragraph**

Applicant accepts the Examiner's invitation and will supply the requested information upon receiving an indication of allowable subject matter.

**Rejection of claims 1-4, 8, 11, 12 and 22-35 under 35 U.S.C. §102(b)**

Claims 1-4, 8, 11, 12 and 22-35 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,876,551 to Jackson "as further evidenced by" the Abstract of WO 95/07946. Applicant respectfully traverses the Examiner's rejection.

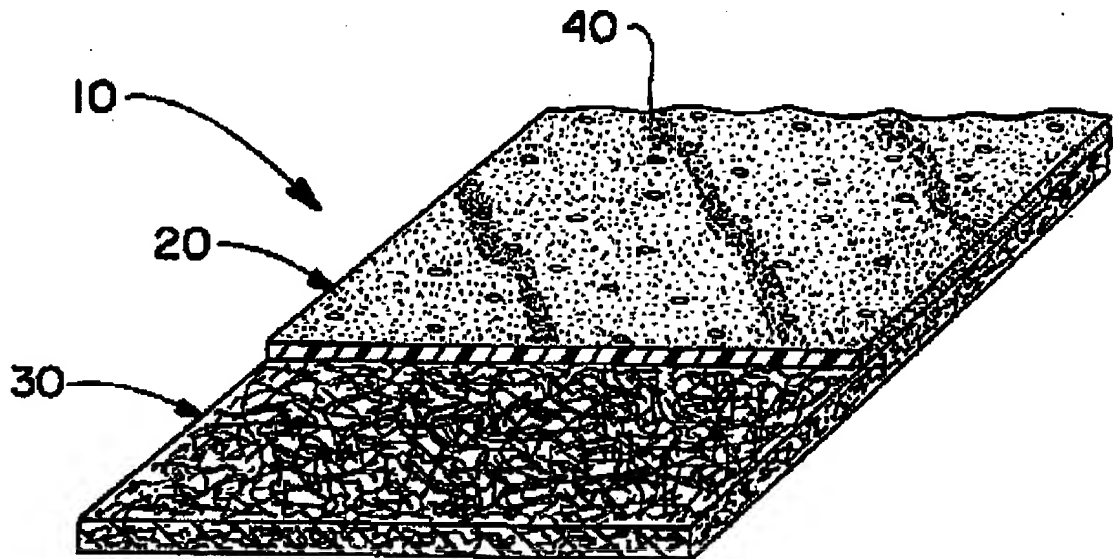
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Jackson discloses "[a] breathable, decorative wall covering having a smooth, continuous, aesthetically appealing exposed surface" (Abstract). In the disclosed embodiment, the covering consists of a porous polymeric ply 20 fused to and supported by a nonwoven substrate ply 30 (col. 3, ll. 36-39). The nonwoven ply 30 is described as being "relatively open and porous," and preferably formed of "hydroentangled" fibers (col. 2, ll. 40-45). The porous polymeric ply 20 is preferably comprised of a plastisol coating (col. 1, l. 59). A "key feature of the coating" is its thinness, which "results in small discontinuities, holes, or gaps, which upon fusion form miniature holes or pores in the fused polymeric ply" (col. 5, ll. 45-52). According to the patent, these discontinuities "are randomly distributed throughout the coating" (col. 2, l. 30) which is shown in the lone figure:



As a result, the polymeric ply "appears to be a continuous, smooth film" to the unaided eye (col. 2, l. 32), even though it actually includes the "randomly distributed discontinuities" formed as a "key feature" of the invention.

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The present invention, on the other hand, as in modified claim 1 (and dependent claims 2-13), describes a polymeric wall covering material having a thermoplastic coating material applied to the non-woven fiber tissue to provide a regular, roller paintable visible outer surface. (Emphasis added). The thermoplastic coating is added to the non-woven material to reduce the amount of paint necessary to impart a smooth surface on the wall covering. Independent claim 23 as modified also requires a polymeric wall covering material having a thermoplastic coating material applied to the non-woven fiber tissue to provide a regular, roller paintable visible outer surface, as well as a layer of paint "roller-applied." (Emphasis added).

As one of ordinary skill appreciates, a regular roller paintable visible outer surface would allow paint or other surface enhancements to be applied to the outer surface more easily, therein improving the aesthetic characteristics of the fiber reinforced wall covering. Jackson, on the other hand, does not form a regular roller paintable outer surface, but instead forms surface having "randomly distributed discontinuities." As one of ordinary skill appreciates, these discontinuities are deleterious from the standpoint that they would more readily receive any paint applied to the surface, thus magnifying the imperfect, or "irregular" nature of the surface. Indeed, this is why the use of special methods of printing using ink are disclosed, including "Gravure, flexography, screen printing, jet printing, [and] web printing" (col. 6, ll. 29-30). Such a result is avoided by Applicant's claimed "regular" surface, which may for example be painted using a conventional roller.

Turning to claim 23, the "layer of paint roller" limitation is confusing because it is taken completely out of context. The claim actually reads "a layer of paint roller applied" (that is, applied by a roller). To make the context clear, a hyphen is inserted between the words "roller" and "applied" in this claim.

As for the assertion that Jackson discloses such a layer, Applicant respectfully submits that it does not. As the Examiner admits, Jackson describes "various methods of printing" using ink "to form desirable decorative patterns and designs." In contrast, claim 23 requires a layer of "paint " that is roller-applied. Regardless of whether ink equates

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with paint or "screen printing is very similar to the concept of painting by using a roller" as contended, the requisite identity necessary to support an anticipation rejection is plainly lacking. Jackson simply does not teach a wall covering painted using a roller, and no skilled artisan would equate screen painting with roller painting. Accordingly, the rejection is improper and must be withdrawn, since the cited prior art does not disclose a layer of roller-applied paint.<sup>1</sup>

As for any reiteration that the "regular" limitation is indefinite because it is not "defined by the specification," Applicant respectfully submits that the specification need not expressly define the terms used in the claims. Moreover, "[t]he fact that the claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph." Section 2173.05(b) MPEP, ch. 2100, pp. 208-209. Rather, "acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification." *Id.*

Here, a skilled artisan would perfectly understand what is meant by a "regular" surface in claims 1 and 23 in light of the teachings of the accompanying specification, regardless of the absence of any express definition, and nothing in the present record suggests otherwise. Bolstering this conclusion is this Examiner's recent allowance of U.S. Patent No. 6,407,016 to Van Steenlandt et al. covering a reinforced knitted structure including metal fibers. This patent includes "regular" as a limitation in claim 1, but includes no express definition of this term in the specification (and, in fact, uses the term sparsely - a sign that it is well understood by skilled artisans).

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<sup>1</sup> With regard to the assertion that a "roller-applied" paint layer constitutes a mere intended use, the Examiner's attention is directed to Hazani v. U.S. International Trade Commission, 44 U.S.P.Q. 2d 1358 (Fed. Cir. 1997), in which it was held that the limitation "chemically engraved" in a claim describes the product more by its structure than by the process used to obtain it. See also In re Garner, 412 F.2d 276, 278-79, 162 U.S.P.Q. 221, 223 (CCPA 1969) ("it seems to us that the recitation of the particles as 'interbonded one to another by interfusion between the surfaces of the perlite particles' is as capable of being construed as a structural limitation as 'intermixed,' 'ground in place,' 'press fitted,' 'etched,' and 'welded,' all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations").

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The independent patentability of several of the dependent claims over the Jackson patent is also noted. For example, dependent claim 2 requires that the roller paintable, visible outer surface of the thermoplastic polymer coating has a surface tension of at least approximately 30 dynes/cm. The Jackson reference is completely silent as to the claimed surface tension, and the Examiner does not contend otherwise. Accordingly, the anticipation rejection of this claim is improper and must be withdrawn.

Similar to dependent claim 5 (which is not rejected over Jackson), dependent claim 27 requires that the thermoplastic polymer coating comprises a matrix polymer resin selected from the group consisting of low density polyethylene, high density polyethylene, polypropylene, and combinations thereof. On page 5 of the Office Action, the Examiner fully admits that Jackson "fails to explicitly disclose the use of polyethylene and polypropylene resins." Nevertheless, it allegedly anticipates claim 27, as well as claims 28-29, 31-32, and 35 which depend therefrom.

Axiomatically, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" Section 2131 MPEP, ch. 2100, p. 73. "Normally, only one reference should be used" in making an anticipation rejection. Section 2131.01 MPEP, ch. 2100, p. 73. However, reliance on a second reference in support of an anticipation rejection has been held proper when it is cited to: (1) prove the primary reference contains an enabled disclosure; (2) explain the meaning of a term used in the primary reference; or (3) show that a characteristic not disclosed in the reference is inherent. Section 2131.01 MPEP, ch. 2100, p. 74.

The Examiner admits that Jackson does not disclose "each and every element of the claim," as required for a proper anticipation rejection. Nevertheless, she relies on a second reference, WO 95/079946 to evidence that "the use of resins such as polyethylene in plastisol form to produce a coating material is known in the art." That the use of polyethylene in plastisol form is "known in the art" is irrelevant to the consideration of whether Jackson anticipates claim 27 or claims 28-29, 31-32, and 35. Rather, the proper consideration is whether "each and every element as set forth in the claim is found, either

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expressly of inherently described" in Jackson. Since the Examiner admits that such is not the case, the rejections of these claims are believed to be improper and must be withdrawn.

The irrelevance of WO 95/079946 to Applicant's field of endeavor also makes it non-analogous, thereby precluding its use in any prospective obviousness rejection.

Like claim 6 (also not rejected over Jackson), claim 28 as modified also requires that the thermoplastic polymer coating further comprises a mineral filler to create a non-smooth outer surface. (Emphasis added). As observed in the present specification, this non-smooth surface "allows paint rollers used to coat the polymeric surface with commercial paint to roll, not slide, thereby imparting a smooth and continuous paint surface requiring only one coat" (p. 11, last paragraph).

The stated need met by Jackson is to provide a breathable wallcovering having "a relatively higher permeability, yet which has a smooth outer exposed surface" (col. 2, l. 15). Indeed, this type of smooth surface is contrasted from the prior art approaches for wall coverings having a "textured" surface formed on a woven backing. Thus, it cannot possibly anticipate the invention of modified claim 28, regardless of whether the use of polyethylene in plastisol form is "known in the art."

Likewise, claim 29 requires that the mineral filler of claim 28 is selected from the group consisting of calcium carbonate, mica, talcum, clay, and combinations thereof. Nowhere are such compounds or combinations thereof found within the four corners of Jackson. Accordingly, it alone cannot anticipate this claim, as contended, for this additional reason.

Dependent claim 30 requires that the wall covering material has a water vapor transmission rate of at least approximately 1 gram/m<sup>2</sup> per day as measured by DIN Standard 52615 utilizing a wet cup process, which limitation is also found in dependent claim 8. Despite referencing a permeability range of 25-50 perms, nowhere does the reference equate this with the claimed vapor transmission rate (and, in fact, appears to disparage a lower rate; see col. 1, ll. 54-59). Accordingly, Jackson cannot anticipate this claim, either.

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Nowhere does Jackson disclose that the amount of the opacifying agent in the thermoplastic polymer coating is sufficient to create an opacity in the wall covering of between approximately 70 and 90%. Accordingly, it cannot anticipate dependent claim 32, as contended for this reason alone.

Finally, dependent claim 35 requires that the polymeric material comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, titanium dioxide, and a dispersion comprising of ground calcium carbonate and ground titanium dioxide in high density polyethylene. Applicant finds no such disclosure anywhere within the four corners of Jackson, nor is such a teaching provided by WO 95/07946. Accordingly, the anticipation rejection made is improper and must be withdrawn.

Summarizing the foregoing, none of claims 1, 3-5, 11-12, and 22-35 is anticipated by Jackson (which cannot properly be combined with WO 95/07946 in support of such rejections). Reconsideration of these claims is thus respectfully requested.

**Rejection of claims 1, 3-5 and 11-12 under 35 U.S.C. §102(e)**

Claims 1, 3-5 and 11-12 stand rejected as being anticipated by Gundberg et al. (U.S. Patent No. 6, 203,646). Applicant respectfully traverses the Examiner's rejection.

As previously noted, Gundberg et al. discloses a fibrous thermoplastic netting layer adhered around at least a part of the surfaces of a mineral fiber base layer for use as thermal and acoustic insulation (see Column 1, lines 18-19 and Column 9, lines 50-51). As shown in Figure 1, a netting 13 of fibers or filaments 11 of thermoplastic is deposited on the surface of a mineral fibre web 12. (Emphasis added) Alternatively, in another preferred embodiment, as shown in Figure 3 and described in Column 7, beginning at line 1, a polymer melt in the form of fibres or filaments 36 is dispensed from pressure guns 35 on the upper side of a mineral fibre web 37 so as to form a coherent netting 38. (Emphasis added). The surface coating is added in Gundberg et al. to increase the tactility of the mineral fiber material during handling, and thus is limited to a surface weight between 2 and 50 g/m<sup>2</sup>. The surface coating is also added to impart additional strength to the fibers.

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Further, as stated in Example 1, Column 8, line 16, the surface coating had the appearance of a non-woven material. (Emphasis added)

The present invention, on the other hand, as in modified claim 1 (and dependent claims 2-13), describes a polymeric wall covering material, not an insulating material, having a thermoplastic coating material applied to the non-woven fiber tissue to provide a regular roller paintable visible outer surface. (Emphasis added). The thermoplastic coating is added to the non-woven material to reduce the amount of paint necessary to impart a smooth surface on the wall covering, not to improve the strength and tactility of the underlying fibers. Moreover, the coating is regular, which is contrasted from the netting having the appearance of the underlying non-woven material that results in the Gundberg et al. approach.

As one of ordinary skill appreciates, a regular, visible outer surface would allow for the application of paint using a roller, therein improving the aesthetic characteristics of the fiber reinforced wall covering. Gundberg, on the other hand, does not form a regular roller paintable outer surface, but instead forms a netting that has the appearance of a non-woven material (i.e., a coherent netting). Any skilled artisan would appreciate that a netting layer is not easily paintable, especially with a roller applicator. In fact, a roller applicator would not even be considered to paint the thermoplastic netting layer in Gundberg, as it would be impossible to paint every surface of the filaments easily. In fact, the very reason for adding the thermoplastic material in the present invention is to change the surface characteristics of the non-woven material to make it more paintable, especially with a roller applicator, while the thermoplastic in Gundberg et al. maintains a non-woven appearance (see Column 8, lines 16-17).

In the remarks on page 7 of the Office Action, the Examiner notes that the reference teaches the use of the same thermoplastic polymer materials. However, as stated previously, this point is irrelevant, because the materials are not being used to form a coating having a paintable outer surface, instead they are being used to form a netting over the matting to provide additional thermal and acoustical properties and to prevent fiber



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loss before, during and after installation of an insulation material. Thus, the thermoplastic polymer coating surface formed in the present application is substantially different than that formed in Gundberg.

As such, modified claim 1, and dependent claims 3-5 and 11-12 are not anticipated by Gundberg. Reconsideration of claims 1, 3-5 and 11-12 is thus respectfully requested.

**Rejection of claim 2 under 35 U.S.C. §102(e) or, alternatively, under §103(a)**

Claim 2 stands rejected under 35 U.S.C. §102(e) or, alternatively, under §103(a). As described above, modified claim 1 is not anticipated by Gundberg. As such, dependent claim 2 is similarly not anticipated by Gundberg.

As indicated above, the fibrous thermoplastic netting layer adhered to a mineral fiber base layer in Gundberg et al. is used as an insulator, not a polymeric wall covering, and is therefore used to improve the acoustical and thermal properties of the mineral fibers by providing a netting over the fibers themselves. The coating also helps to minimize the release of fibre wads or single fibers to the surroundings before, during and after mounting. It does not create a regular paintable surface, especially a surface that can be easily painted with rollers, as in the present invention.

Surface tension, as one of ordinary skill appreciates, is important to determine how easily one substance will flow over and coat onto another substance. In the present application, surface tension is important in applying and adhering paint to an outer surface of a material. In the case of Gundberg, the painting of the mineral fibers and or polymeric filament netting in Gundberg et al. with a roller to obtain a pleasing aesthetic surface would be highly impractical, if not impossible. The roller would have to be manipulated in such as way as to coat each nook and cranny.

Claim 2 is therefore neither anticipated by nor obvious in view of the cited prior art. Reconsideration of claim 2 is respectfully requested.

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**Rejection of claim 6 and 7 under §103(a)**

Claims 6 and 7 stand rejected as being unpatentable over Gundberg, as applied to claims 1, 3-5, and 11-12 above, as applied to Penz et al. (U.S. Patent No. 5,888,913). Applicant respectfully traverses the Examiner's rejection.

Section 2143 of the Manual of Patent Examining Procedure states that three basic criteria must be met for establishing a *prima facie* case of obviousness, stating:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all of the claim limitations."

"If the examiner does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Section 2142 MPEP, ch. 2100, p. 110. "When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned."<sup>2</sup> One cannot use hindsight reconstruction, picking and choosing among isolated disclosures in the prior art, to deny that the claimed invention is unobvious.<sup>3</sup>

Penz et al. discloses a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber.

It would not be obvious to combine Gundberg et al. and Penz et al. to arrive at the present invention. No reason is shown why one of ordinary skill in the art would modify Gundberg et al. as the Office Action proposes. Here, the Examiner is utilizing Penz et al. to include a mineral filler in the chemical composition of the polymeric fiber coating of Gundberg et al. as is presented in claims 6 and 7. This would result, in Gundberg et al., in

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<sup>2</sup> *In re Ochial*, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), citing *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

<sup>3</sup> *In re Fine*, 837 F.2d at 1075.

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mineral filler containing polymeric material in strand or filament form coupled to the non-woven mat structure in the form of a net coating (which again, is in stark contrast to the regular, roller paintable outer surface claimed). Applicant respectfully suggests that there would be no motivation to combine Gundberg et al. and Penz et al. to arrive at the present invention as in present claims 6 and 7, as the addition of mineral filler to the composition of Gundberg et al. would still not result in paintable outer surface (especially with a roller application) for a wall covering material as in claims 6 and 7.

Hence claims 6 and 7 are not obvious in view of the cited prior art. Reconsideration of claims 6 and 7 is respectfully requested.

**Rejection of claim 9, 10, 13 under 35 U.S.C. under §103(a)**

Claims 9, 10 and 13 stand rejected as being unpatentable over Gundberg, as applied to claims 1, 3-5, and 11-12 above, and further in view of Melber (U.S. Patent No. 4,898,892). Applicant respectfully traverses the Examiner's rejection.

Melber discloses a method for making an opaque coating comprising employing opacifiers into or onto the surface of thermoplastic microspheres.

It would not be obvious to combine the Gundberg et al. and the Melber et al. to arrive at the present invention. No reason is shown why one of ordinary skill in the art would modify the Gundberg et al. as the Office Action proposes. As stated previously with regards to mineral fillers, the addition of an opacifying agent of Melber to the polymeric netting coating of Gundberg et al. would still not result in a roller paintable outer visible surface of a polymeric wall covering material as in claims 9, 10 and 13. As such, there would be no reason to combine the opacifying enhancement characteristics described in the Melber reference with Gundberg et al. to arrive at claims 9, 10 and 13 as proposed.

Hence, claims 9, 10 and 13 are not obvious in view of the cited prior art. Reconsideration of claims 9, 10 and 13 is respectfully requested.

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**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant submits that claims 1-13 and 22-35 are in proper form and allowable over the cited prior art. The Examiner is invited to telephone the Applicant's undersigned attorney at (740) 321-7167 if any unresolved matters remain, and may debit any fees due from Deposit Account 50-0568.

Respectfully submitted,

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